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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,111	03/26/2001	Rabindranath Dutta	AUS920010052US1	7745

7590

05/03/2004

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EXAMINER

RIMELL, SAMUEL G

ART UNIT

PAPER NUMBER

2175

121

DATE MAILED: 05/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/817,111

Applicant(s)

DUTTA ET AL.

Examiner

Sam Rimell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-54 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

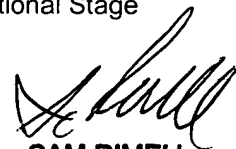
Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.



SAM RIMELL
PRIMARY EXAMINER

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 7-10, 13, 14, 17, 19-21, 25-28, 31, 32, 35, 37-39, 43-46, 49, 50 and 53 are rejected under 35 U.S.C. 102(e) as being anticipated by Van Stam (U.S. Pre-Grant publication 2003/0014759, effective filing date December 21, 1999).

Claim 1: Van Stam discloses peer-to-peer networks (20) communicating with a server (10). Accordingly, the system of Van Stam is programmed so as to allow a user at a first peer node to enter keywords, which would be the entry of a URL address to contact the server (10). The URL address (keywords) are sent in a message to the server so that contact is made with the server (10). The server then returns to the first node a listing of all the peers currently connected to the network and their network node addresses (paragraph 0020, lines 5-9).

The listing of nodes provided to each peer is a complete listing of all the nodes connected to the network. Since at least some of the nodes will share lists (files) with other nodes, the listing of nodes inherently includes those nodes from which a file was retrieved by another peer at some point during the exchange of files.

The first peer then conducts queries with secondary peers in order to download data (paragraph 0030, lines 9-10). The data is downloaded from peers identified by the server. The URL used by the peers to connect to the network is considered to be a query, in addition to the queries exchanged between the peers to obtain data.

Claim 2: Van Stam permits the first peer node to obtain a search result message from a second peer node (paragraph 0028, lines 5-7) and retrieve files from the second peer node (paragraph 0030, lines 9-10).

Claim 3: Paragraph 0020, lines 5-9 state the user is displayed all of the peer nodes on the network. This reads as a capturing of those peer nodes. The listing of peer nodes are maintained (saved) for the duration of each peer's connection to the network (paragraph 0012, lines 3-4).

Claim 7: Every peer node on the network is registered with the server and the list of nodes is shared with all the other peers (paragraph 0020, lines 5-9).

Claim 8: Any graphical user interface which each peer uses to communicate on the network (i.e. an internet web page, paragraph 0011, line 15) is readable as the rating module which is received on the peer node. Also note that this module is readable as a rating module because the users rate each other before sharing information (paragraph 0028).

Claim 9: The rating module (graphical user interface at the peer) is presented to the given user when they connect with the server.

Claim 10: The step of entering a URL to contact the server (20) is the step of having the server receive a rating request message having a keyword (the URL). Each peer is considered to be a rating database and searches are made between peers. In setting up the network, the server (20) retrieves the addresses of peer nodes on the network and sends the complete address list of node identifiers to each peer (paragraph 0020, lines 5-9).

The listing of nodes provided to each peer is a complete listing of all the nodes connected to the network. Since at least some of the nodes share lists (files) with other nodes, the listing of

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nodes inherently includes those nodes from which a file was retrieved by another peer at some point during the exchange of files.

Claim 13: Every peer node on the network is registered with the server and the list of node sis shared with all other peers (paragraph 0020, lines 5-9).

Claim 14: Any graphical user interface which each peer uses to communicate on the network (i.e. an internet web page, paragraph 0011, line 15) is readable as the rating module which is received on the peer node. Also note that this module is readable as the rating module because the users rate each other before sharing information (paragraph 0028).

Claim 17: Any given user is readable as a rating peer node since the users have the capability to rate each other (paragraph 0028). Access is provided without a specified fee.

Claim 19: See remarks for claim 1.

Claim 20: See remarks for claim 2.

Claim 21: See remarks for claim 3.

Claim 25: See remarks for claim 7.

Claim 26: See remarks for claim 8.

Claim 27: See remarks for claim 9.

Claim 28: See remarks for claim 10.

Claim 31: See remarks for claim 13.

Claim 32: See remarks for claim 14.

Claim 35: See remarks for claim 17.

Claim 37: See remarks for claim 1.

Claim 38: See remarks for claim 2.

Claim 39: See remarks for claim 3.

Claim 43: See remarks for claim 7.

Claim 44: See remarks for claim 8.

Claim 45: See remarks for claim 9.

Claim 46: See remarks for claim 10.

Claim 49: See remarks for claim 13.

Claim 50: See remarks for claim 14.

Claim 53: See remarks for claim 17.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12, 15, 18, 30, 33, 36, 48, 51 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Stam.

Claims 12: Van Stam differs from the claims in that it does not disclose a given peer initiating a financial transaction with another peer in order to grant the other peer access to information. However, Examiner takes Official Notice that it is very well known in the art to provide information to users in exchange for a fee. It would have been obvious to one of ordinary skill in the art to modify Van Stam to permit fee transactions between peers in exchange for information as is very known in the art for generating revenues on the Internet.

Claim 15: Van Stam differs in that it does not call for requiring a fee to access the network. However, Examiner takes Official Notice that it is very well known in the art to require

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fees from users accessing networks. For example, Internet Service Providers and news providers such as CNN require user fees to access portions of their networks. It would have been obvious to one of ordinary skill in the art to modify Van Stam to require fees to access the peer-to-peer network as is very known in the art for generating revenues on the Internet.

Claim 18: Van Stam differs from the claims in that it does not disclose a given peer initiating a financial transaction with another peer (each peer has a rating database). However, Examiner takes Official Notice that it is very well known in the art to provide information to users in exchange for a fee. It would have been obvious to one of ordinary skill in the art to modify Van Stam to permit fee transactions between peers in exchange for information as is very well known in the art for generating revenues on the Internet.

Claim 30: See remarks for claim 12.

Claim 33: See remarks for claim 15.

Claim 36: See remarks for claim 18.

Claim 48: See remarks for claim 12.

Claim 51: See remarks for claim 15.

Claim 54: See remarks for claim 18.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 4, 5, 6, 11, 16, 22, 23, 24, 29, 34, 40, 41, 42, 47 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Stam in view of Carey et al (U.S. Pre-Grant publication 2002/0112035, effective filing date of October 30, 2000).

Claims 4, 5, 6 11, 16: Each of claims 4, 5, 6, 11 and 16 differ from Van Stam in the step of sending client rating information and statistical information to the server. However, paragraphs 0167 and 0174 of Carey et al. discloses the step of sending evaluation information to a server (114) from users (116). The evaluation information can include rating information (outcomes-paragraph 0167) or statistical information (what the user did or did not click while on the system-paragraph 0174). It would have been obvious to one of ordinary skill in the art to modify Van Stam to permit the server to collect user ratings and statistics for marketing purposes as taught by Carey et al.

Claims 22, 23, 24, 29, 34: These claims correlate to claims 4, 5, 6 11 and 16 respectively.

Claims 40, 41, 42, 47 and 52: These claims correlate to claims 4, 5, 6, 11 and 16 respectively.

Remarks

(1) Consideration of Declaration under 37 CFR 1.131: The declaration of Rabindranath Dutta signed February 4, 2004 includes a declaration that the inventor reduced the invention to practice prior to October 30, 2000. The prior art applied are the references to Van Stam, which claims priority to December 21, 1999, and Carey et al., which claims priority to October 30, 2000. Thus, regardless of the findings, the declaration does not overcome the Van Stam reference because the

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declaration does not specifically claim the reduction practice as prior to the December 21, 1999 date claimed by Van Stam.

In reviewing the declaration, applicant recites a reduction to practice prior to October 30, 2000 and relies upon Exhibit A (13 pages) as supporting the statement that the invention was reduced to practice. In reviewing the 13 pages of Exhibit A, examiner does not find sufficient evidence that the invention was reduced to practice. The 13 pages of Exhibit A are merely a discussion of problems identified in the prior art, accompanied by schematic diagrams of proposed solutions and further including news articles discussing desirable future systems. Such information does not constitute evidence of an invention that completed and fully operational prior to October 30, 2000. At best, the exhibit merely provide some basic outlines of a desired system, and is not evidence of a fully operational and fully programmed system. In addition, the information in Exhibit A does not fully correlate with the claimed invention. In particular examiner does not find any part of exhibit A that discloses a listing of nodes where the listed nodes are those from which a file has been previously retrieved in response to a peer-to-peer search that used a keyword in a list of keywords.

Accordingly, the declaration under 37 CFR 1.131 is not effective in overcoming the application of the Carey et al. reference by establishing a reduction to practice prior to October 30, 2000.

37 CFR 1.131 also allows a declaration to antedate a prior art reference by establishing a date of conception followed by diligence towards reduction to practice by filing the patent application. Examiner has also reviewed the declaration to determine if it is effective in establishing conception and diligence. However, examiner finds that the declaration does not

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establish any dates of diligence, by reason that all of the activity dates have been redacted. MPEP 715.07 (Section entitled "Establishment of Dates") states that in order to prove diligence under 37 CFR 1.131, the actual dates of activities related to diligence must be provided. Since all of the activity dates have been redacted, there is essentially no evidence of diligence.

Accordingly, the declaration under 37 CFR 1.131 is not effective in overcoming the application of the Cary et al. reference by establishing conception followed by diligence.

(2) Consideration of arguments: Applicant's arguments are primarily directed to the amendments set forth in each of the independent claims 1, 10, 19, 28, 37 and 46. Each of the amendments set forth in these claims are essentially the same. Examiner maintains that the reference to Van Stam anticipates the features which have been amended into each of the independent claims. The rationale is recited in the second paragraph of explanation associated with each of claims 1 and 10. Rather than repeat this rationale here, applicant is requested consider the rationale provided in these recited sections.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (703) 306-5626.



Sam Rimell
Primary Examiner
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